

REMARKS/ARGUMENTS

Claims 25-50 are pending in the present application.

In the Office Action, claims 25-26, 29, 45 and 47 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,998,129 to Schutze et al. ("Schutze '129"). Claims 25-26, 29, 45 and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of U.S. Application Pub. No. 2004/0252291 ("Schutze '291"). Claims 27 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schutze '129 in view of Schutze '291 and further in view of XP-0002269476 to Schachter et al. ("Schachter"). Claims 30-37 and 48-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of Schutze '291, Schachter and further in view of DE 19636074 ("Mengel"). Claims 38, 46 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of Schutze '291 and further in view of U.S. Application Pub. No. 2002/0025511 ("Bova"). Claims 39-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of Schutze '291 and further in view of U.S. Application Pub. No. 2002/0048747 ("Ganser"). Claims 41-42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of Schutze '291, Ganser, and further in view of U.S. Patent 6,377,710 ("Saund"). Claim 43 was rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of Schutze '291 and further in view of U.S. Application Pub. No. 2001/0053245 ("Sakai"). Claim 44 was rejected under 35 U.S.C. §103(a) as being unpatentable over Schutze '129 in view of Schutze '291, Schachter and further in view of WO 03036266 ("Schuetze").

Reconsideration of the application in view of the following remarks is respectfully requested.

Rejections under 35 U.S.C. §102(b)

Claims 25-26, 29, 45 and 47 were rejected under 35 U.S.C. §102(b) as being anticipated by Schutze '129.

It is respectfully submitted that Schutze '129 fails to teach "automatically calculating a contour of the at least one object" and "automatically defining, based on the calculated contour, a nominal cutting line around the at least one object to be cut out" as recited in claim

25 of the present application. In contrast, the object outline of Schutze '129 is produced by a microscope slide moved either by hand (controlled by a mouse or joystick) or which travels automatically under the control of a computer program in accordance with a predetermined pattern in an essentially circular or spiral shape around the chosen object 10. See Schutze '129, column 7, lines 9-15. The object outline in Schutze '129 therefore is either done by hand or follows a predetermined pattern. No automatic calculation of a contour of the at least one object is made, and an automatically calculated contour is not used to automatically define a nominal cutting line, as required by claim 25.

Because Schutze '129 fails to teach the above-recited features of independent claim 25, it is respectfully submitted that Schutze '129 cannot anticipate claim 25 or any of its dependent claims 26, 29, 45 and 47.

Reconsideration and withdrawal of the rejection of claims 25, 26, 29, 45 and 47 under 35 U.S.C. § 102(b) based on Schutze '129 is respectfully requested.

Rejections under 35 U.S.C. §103(a)

Regarding the alternative rejection of at least claim 25 in the Office Action given Schutze '129 in view of Schutze '291, it is respectfully submitted that neither Schutze '129, as shown above, nor Schutze '291, teaches or suggests automatically defining, based on the calculated contour, a nominal cutting line around the at least one object to be cut out as recited in claim 25 of the present application.

In contrast, Schutze '291 describes that its system is equipped with an automatic surface area calculation function which is merely used to calculate a surface area enclosed by a manually drawn cutting line after the drawing of a cutting line around the desired object. See Schutze '291 paragraphs [0015] and [0042]. Schutze '291 in fact specifically states that each biological object is marked or selected by a freehand cutting line 16. See Schutze '291 paragraph [0042]. Schutze '291 thus does not disclose that a cutting line is automatically defined based on a calculated contour as required by claim 25. Rather, it describes a calculation of the surface area that occurs after a cutting line has been determined.


Based on the foregoing, it is respectfully submitted that neither Schutze '129, nor Schutze '291, alone or in combination, teach or suggest automatically defining, based on the calculated contour, a nominal cutting line around the at least one object to be cut out, as recited in claim 25. Nor do any of the other cited references cure the deficiencies of a combination of Schutze '129 and Schutze '291. Thus, any combination of Schutze '129 and Schutze '291 with any of Schachter et al., Mengel, Bova, Ganser, Saund, Sakai et al. and Schuetze, could not render claim 25 or any of its dependent claims obvious.

Reconsideration and withdrawal of the respective rejections of claims 28, 30-43, 44, 46 and 48-50 under 35 U.S.C. § 102(a) based on combinations of Schutze, Schachter, Mengel, Bova, Ganser, Saund, Sakai and Schuetze is respectfully requested.

CONCLUSION

Applicants believe that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Erik R. Swanson". The signature is written in a cursive, flowing style with a large initial "E".

Erik R. Swanson, Reg. No. 40,833
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: August 24, 2010